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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,401	08/08/2001	Jung-Wan Ko	1293.1059-D	3413

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EXAMINER

CHIEU, PO LIN

ART UNIT	PAPER NUMBER
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2615

10

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/923,401

Applicant(s)

KO ET AL.

Examiner

Polin Chieu

Art Unit

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,7-10 and 12-18 is/are allowed.
- 6) ☒ Claim(s) 2-6 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/263,816.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 12/22/03 have been fully considered but they are not persuasive. The Applicant intended to eliminate Heo under 35 U.S.C. 103(c). The information cited by the Applicant states, "shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to assignment to the same person." The Applicant states that Heo and the instant application are commonly owned; however, the examiner cannot assume that they were at the time the invention was made. The following section provides guidelines for establishing common ownership as outlined by the MPEP.

Applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person.

"Application X and Patent A were, at the time of the invention of Application X was made, owned by Company Z"

This statement alone is sufficient evidence to qualify Patent A from being used in a rejection under 35 U.S.C. 103(a) against the claims of Application X.

MPEP 706.02(1)(2) II. EVIDENCE REQUIRED TO ESTABLISH COMMON OWNERSHIP. Therefore, common ownership has not been properly established and the rejection using Heo is still proper. However, the examiner has presented an

alternative rejection that does not appear to be subject to 35 U.S.C. 103 (c). Since a new rejection is being presented the following Office Action is non-final.

Terminal Disclaimer

2. The terminal disclaimer filed on 12/22/03 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on U.S. Application No. 09/263816, 09/583877, 09/923322, 09/923323, 09/924094, 09/923361, 09/583876, 09/927500, 09/927495, 09/927494, 09/927496, 09/927491, 09/923400, 09/923321, and 09/923399 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-6 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kajiyama et al in view of Heo (6,222,983).

Regarding claims 2, Kajiyama et al discloses an audio area including audio and linking information (figs. 4 and 5); a catalog area other than the audio area which includes catalog information related to the audio data (figs. 4 and 5); the catalog information comprising common catalog information commonly applied for more than

one of the audio data recorded on the storage medium, and title catalog information corresponding to each of the audio data (fig. 5), and during reproduction of the audio data, the linking information connects the corresponding catalog information to be reproduce with the audio data (fig. 14, col. 5, line 37 – col. 7, line 26). However, Kajiyama et al does not disclose that the catalog information is image information produced according to a DVD video specification; and the storage medium is a DVD.

Heo teaches storing image information according to the DVD video specification on a DVD (fig. 2). Since the catalog information is still picture and sub-picture data, it would have been obvious to store the catalog information as image information because picture and sub-picture data is stored as image information on DVDs.

It would have been highly desirable to store information on a DVD according to the DVD video specifications to that the data could be reproduce by a DVD player; and a DVD has a larger storage capacity than a CD-ROM.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to record according to the DVD video specification in the device of Kajiyama et al.

Regarding claim 3, Kajiyama et al discloses a still picture for a background image; a sub-picture for a caption; and navigation information for controlling the still picture and the sub-picture (figs. 5 and 14).

Regarding claim 4, Kajiyama et al discloses an audio data recording region in which audio data is recorded (figs. 4 and 5); and an audio information recording region for the entire audio data and/or audio data in units of distinct items of the audio data, in

which is stored catalog playback information comprising the linking information connecting the audio data to the catalog information during playback (col. 5, line 37 – col. 7, line 26).

Regarding claim 5, Kajiyama et al does not explicitly disclose how the catalog and audio data are linked. It is well known in the art to provide the location of data to be reproduced. It would have been obvious to provide the location of the catalog information to be played back with the audio data. It would have been highly desirable to provide the location of the catalog information instead of another method of locating the catalog information so that the catalog information can be located quickly without having to perform any complicated processing. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have the location of the catalog information stored in the device of Kajiyama et al.

The limitations of claim 11 were discussed in the art rejection of claim 7. Please refer to the art rejection of claim 7.

Note: The following rejections do not appear to be subject to 35 U.S.C. 103(c).

5. Claims 2, 4-6, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al (6,208,802) in view of Moriyama et al (5,889,746).

Regarding claim 2, Mori et al discloses an audio area including audio data and linking information (fig. 8B-C); during reproduction of the audio data, the linking information connects the corresponding video information to be reproduced with the audio data (col. 16, line 20 – col. 17, line 20), wherein the image information produced

according to a digital versatile disk video (DVD-video) specification (fig. 6), and the storage medium includes an audio region in which the audio data is recorded and an image information record region (fig. 3). However, Mori et al does not disclose a catalog area other than the audio area and which includes catalog information related to the audio data; the catalog information comprising common catalog information commonly applied for more than one of the audio data recorded on the storage medium, and title catalog information corresponding to each of the audio data; and the catalog information is image information.

Moriyama et al teaches common catalog information commonly applied for more than one of the audio data recorded (i.e. album title or artist), and title catalog information (i.e. song title) corresponding to each of the audio data (fig. 12); and catalog information recorded in a catalog area other than the audio area (fig. 9; col. 14, lines 58-67). Although Moriyama et al does not explicitly disclose that the catalog information is image data, the catalog data is stored in an image data region and it is well known in the art to display catalog information including pictures and text while audio data is playing (i.e. karaoke players).

It would have been highly desirable to have catalog information including common catalog information and title catalog information stored in a catalog area other than the audio area so that the data can be used to search for data (fig. 20-22). It would have been highly desirable to have catalog information including pictures and text so that the user could view the artist, song title, lyrics, etc.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have catalog information including common catalog information and title catalog information in a region other than the audio region; and the catalog information is image data in the device of Mori et al.

Regarding claim 4, Mori et al discloses an audio data recording region in which the audio data is recorded; and an audio information recording region for the entire audio data and/or audio data in units of distinct items of the audio data, in which is stored image playback information comprising the linking information connecting the audio data to the image playback information during playback (fig. 8B).

Regarding claim 5, Mori et al discloses the image playback information comprises information on a location of the image information recording region in which the image information is recorded (col. 17, lines 6-20).

Regarding claim 6, Mori et al discloses a file identifier; and an auto presentation information table determining a location of the image information (893) to be played back corresponding to a predetermined time in accordance with real time playback information (884) of audio obtained from the audio data during real time playback (fig. 8B).

Regarding claim 11, Mori et al discloses an audio region in which audio data is stored (fig. 3); and an image information region in which catalog information is stored (discussed in the art rejection of claim 2).

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al in view of Moriyama et al and Tashiro et al (5,654,516).

Regarding claim 3, Mori et al does not disclose catalog information comprising a still picture for a background image; a sub-picture for a caption; and navigation information for controlling the still picture and the sub-picture.

Tashiro et al teaches catalog information comprising a still picture for a background image and a sub picture for a caption (fig. 15). Navigation information is well known in DVD-video for controlling images and sub-picture (i.e. navigation packs or nav packs).

It would have been highly desirable to have still pictures and caption information so that the user is provided image and catalog information during audio playback.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have a still picture and a sub-picture in the device of Mori et al.

Allowable Subject Matter

7. Claims 1, 7-10, and 12-18 are allowed.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mori et al (6,219,488) discloses a DVD.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Polin Chieu whose telephone number is (703) 308-6070. The examiner can normally be reached on M-Th 8:00 AM-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew B. Christensen can be reached on (703) 308-9644. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any response to this action should be mailed to:

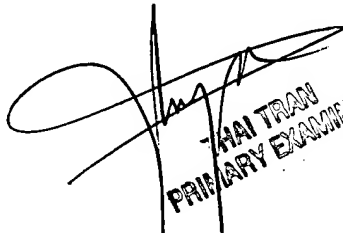
Commissioner of Patents and Trademarks

Washington, D.C. 20231

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

PC
March 22, 2004



TAI TRAN
PRIMARY EXAMINER